

REMARKS

Applicants gratefully acknowledge the Examiner's withdrawal of the previous office action's rejection under 35 U.S.C. § 101.

Claims 1-7 are currently pending in the application. No new matter has been added.

The Claimed Invention

The claimed invention provides a system, a method, a computer program, and a server for use in on-line shopping to enable items in a shopping cart stored in a shopping cart database to be presented to a shopper sequentially rather than simultaneously — *i.e.*, in series rather than all at once — for confirmation of purchases. A shopper's intent to purchase may thus be separately confirmed for each item in a shopping cart at the time of checkout, with items not confirmed being returned to the shopping cart for purchase at a later time instead of being canceled. As a result, a shopper may choose to keep some items in the shopping cart while purchasing others. In addition, when seeking to purchase an item of which limited quantities are available, a shopper who does not want to purchase such item right away may obtain priority for purchasing it at a later time by maintaining the item in his or her shopping cart.

To that end, the claimed invention provides a marketer server 10, a network 20 which may be the Internet, at least one user terminal 30, a shopping cart database 40, a recording medium 50, and an item database 60. A shopper, or user, is thereby enabled to: operate a user terminal 30 to connect to the marketer server 10; select an item to purchase; and cause the marketer server 10 to place the item in the user's shopping cart which is stored in the shopping cart database 40. The recording medium 50 stores the program according to which the marketer server 10 executes these processes. Upon completion of the shopping session, the user may examine the shopping cart and choose to "purchase while examining items one at a time."

(Figure 5) The marketer server 10 then removes one of the items from the shopping cart and presents it to the user who determines, one item at a time, whether to purchase the item at that time or to wait until later. (Figure 6a) Once the choice is made as to one item, the next item in the shopping cart, if any, is presented to the user for confirmation. (Figure 6b) The process continues until the user has reviewed each

item in the shopping cart. (Figure 4) Figures 6a and 6b show that the one-by-one presentation of shopping cart items for confirmation of purchase, according to the claimed invention, may be effective even with a user terminal that has a display significantly smaller than the display of a conventional personal computer.

Rejection of Claims 1-7 Under 35 U.S.C. § 103(a)

Claims 1-7 have been rejected under 35 U.S.C. § 103(a) as suggested by U.S. Patent Application No. 2001/0011239 to Kondoh et al. in view of U.S. Patent No. 5,850,218 to LaJoie et al. Applicants respectfully traverse.

The Examiner admits that features of the claimed invention are absent from Kondoh et al. and relies on LaJoie et al. to provide “an equivalent structure.” (Office Action at 3) Kondoh et al., however, relates to an Internet-based cyber mall, while LaJoie et al. relates to an interactive television programming guide. There is no obvious reason to combine these two inventions as the Examiner has proposed. Kondoh and LaJoie are solving different problems, and use different methods. It would not be obvious to one of ordinary skill in the art that the two references could be combined to achieve anything, and such a combination constitutes impermissible hindsight. To be permitted, what is required is to have some motivation in either or both the claims to make the proposed combination. However, in this case, a cyber mall and an interactive programming guide are completely unrelated to one another.

Indeed, the Examiner’s attempt to explain the motivation for combining Kondoh et al. with LaJoie et al. clearly demonstrates that a proper basis for the combination is lacking:

Kondoh does not teach that the server presents in series individual items to the user, or a confirmation window as a means for confirming at the user terminal an intention to purchase an individual item . . . or a button as a means for accepting an application to purchase only those items which can be confirmed However, LaJoie teaches an equivalent structure Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate th[e] structure of LaJoie into the invention of Kondoh. One or ordinary skill in the art would have been motivated to do so in order to provide the user with additional information about a particular

item prior to purchase so that the user could make an informed decision, as suggested by LaJoie

(Office Action at 3-4) (citations omitted) Thus, the Examiner's justification for combining Kondoh et al. and LaJoie et al. is simply that the result may be argued to be equivalent to the claimed invention. Not only is this impermissible hindsight, but it is also erroneous.

The portions of LaJoie et al. cited by the Examiner to support rejection of Claims 1-7 consist of Figure 25 of LaJoie et al. and that portion of the specification discussing Figure 25. (LaJoie et al., column 29, lines 33-58, cited in the Office Action at 3)

LaJoie et al. teach that a television may be used for Internet browsing. The browsing features taught by LaJoie et al., however, are distinct from the interactive programming guide features. (See LaJoie et al., Abstract; column 1, lines 31-32 and 50-53; column 2, lines 8-11; column 5, lines 45-50) The portion of the disclosure of LaJoie et al. cited by the Examiner to support the rejection relates solely to television programming guide features involving the acquisition of programming through an "Impulse Pay-Per-View" functionality. (LaJoie et al., column 29, lines 33-58, cited in the Office Action at 3). One of ordinary skill in the art would not be able to ascertain how programming guide features of LaJoie et al., which are distinct from Internet browser features, could be combined with the Internet-based cyber mall of Kondoh et al. Since there is no apparent similarity between Internet-based cyber malls and interactive television programming guides, one of ordinary skill in the art would not combine the two references as proposed by the Examiner.

Furthermore, with respect to claim 1, it can be seen that it is required that the marketer server presents in series several items in the shopping cart database, and that confirmation is provided at the user terminal of a intention to purchase an individual item in the shopping cart. Thus, claim 1 contemplates a system where the shopping cart can remain full of items, and where only a portion of the items are purchased. As will be acknowledged by the Examiner, Kondoh only provides a the ability to purchase goods saved in a shopping cart. Kondoh does not make any suggestion whatsoever concerning storing a plurality of items in a shopping cart while purchasing only specific items of the plurality within the shopping cart (i.e., as acknowledged by the Examiner, Kondoh does not show presentation of items

individually in series with a separate action to confirm purchase). This feature is not provided by LaJoie either. All LaJoie discloses is that pay per view programming is made available to a user ((summary of information 498), and selecting a program is accomplished by going through a buy option window 496. Once a selection to buy is made in LaJoie, the person is permitted to watch the pay per view programming. In LaJoie, you have no “shopping cart” full of items that are selected individually from an items database. Rather, the user is provided with a complete listing of all pay per view shows which are available a particular time in LaJoie (i.e., LaJoie is not selecting from a cart of individual selections from amongst all possible selections; rather, LaJoie teaches selecting from amongst all possible selections). Therefore, LaJoie does not show any means for confirming at said user terminal whether or not the user has an intention to purchase an individual item of said items in the shopping cart (which includes items obtained from an items database).

Claims 3 and 5 and 7 of the application include similar requirements as claim 1 (i.e., adding particular items from a item database to a shopping cart, sequentially presenting in series individual items in the cart, and providing confirmation of and acceptance of purchase of only certain items of those which are sequentially presented). These claims, and their dependent claims would be allowable for essentially the same reasons.

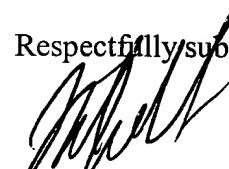
Dependent claims 2, 4, and 6 are separately patentable on the grounds that they require a user's right to purchase preferentially a particular item saved in the shopping cart. This would be important in cases where inventories of products are small. As noted above, the user can purchase some products in the cart by providing a confirmation of an intention to purchase certain items that are presented to the user sequentially. Those items which are not confirmed for purchase; however, remain in the shopping cart, and the user retains some ability to preferentially purchase those items simply because they are temporarily in his or her shopping cart. The Examiner takes the erroneous position that Kondoh teaches this at paragraph 218. However, with reference to paragraph 218 of Kondoh, all that is disclosed is the ability to purchase the goods in the shopping cart (there is no preferential treatment for items the user saves in the shopping cart taught in this passage).

Conclusion

In view of the foregoing, it is respectfully requested that the application be reconsidered, that Claims 1-7 be allowed, and that the application be passed to issue. Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees for the petition or for entry of this amendment to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson P.C.).

Respectfully submitted,



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